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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,893	12/01/2000	Dennis Bigg	427 038	9852

20311 7590 02/21/2003

MUSERLIAN AND LUCAS AND MERCANTI, LLP  
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NEW YORK, NY 10016

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/21/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.  
09/701,893

Applicant(s)  
BIGG et al.

Examiner  
Brenda Coleman

Art Unit  
1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Feb 5, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Feb 5, 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

The amendment filed January 13, 2003 contains a definition of the variables R.sub.2a' and R.sub.2b' which are broader than the definitions which were initially examined as submitted in the preliminary amendment.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 3, 4, and 9-13

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☐ Other: \_\_\_\_\_

*Brenda Coleman*  
BRENDA COLEMAN  
PRIMARY EXAMINER  
ART UNIT 1624

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### ADVISORY ACTION

Claims 3, 4 and 9-13 are pending in the application.

An appeal under 37 CFR 1.191 was filed in this application on February 5, 2003.

Appellant's brief is due on April 5, 2003 in accordance with 37 CFR 1.192(a).

The amendment filed February 5, 2003 under 37 CFR 1.116 in reply to the final rejection has been entered, but is not deemed to place the application in condition for allowance.

The applicant's request for reconsideration and entry of the amendment filed January 13, 2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will **not** be entered because: the new matter presented in the claims of the response filed January 13, 2003 is such that the definition of  $R_{2a'}$  and  $R_{2b'}$  are such that  $R_{2a'}$  and  $R_{2b'}$  are individually hydrogen or methyl, **ethyl, propyl, butyl, pentyl, hexyl, heptyl, methoxyethyl, ethoxyethyl, dimethylaminoethyl, cyclohexylmethyl, phenyl, diphenyl, benzyl unsubstituted or substituted with -OH or methoxy, phenethyl, naphthylmethyl and indolylmethyl**. The preliminary amendment filed January 8, 2001, for which a search was conducted defines the variables  $R'_{2a}$  and  $R'_{2b}$  are individually hydrogen or methyl.

### *Response to Arguments*

Applicants' arguments filed May 31, 2002 have been fully considered with the following effect:

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1. With regards to the 35 USC § 112, enablement rejection of claims 3, 4, 9, 10, 12 and 13 of the office action dated August 8, 2002, the applicant's amendment to claim 9 is sufficient to overcome this rejection however, since the amendment filed January 13, 2003 has not been entered the rejection of claims 3, 4, 10, 12 and 13 is herein maintained.
2. With regards to the 35 U.S.C. § 112, second paragraph rejection of claims 3, 4, 9, 10, 12 and 13 of the office action dated August 8, 2002, labeled a) the applicant's amendment to claim 9 is sufficient to overcome this rejection, however, since the amendment filed January 13, 2003 has not been entered the rejection of claims 3, 4, 10, 12 and 13 is herein maintained.
3. With regards to the 35 U.S.C. § 102, anticipation rejection maintained in the office action dated August 8, 2002, the applicant's amendments filed January 13, 2003 has not been entered and thus the rejection of claim 11 is herein maintained.
4. With regards to the 35 USC § 103, obviousness rejection maintained in the office action dated August 8, 2002, the applicant's amendments filed January 13, 2003 has not been entered and thus the rejection of claims 3, 4 and 9-13 is herein maintained.
5. With regards to the 35 U.S.C. 112, second paragraph rejections of claims 3, 4 and 9-13 which were newly added in the office action dated August 8, 2002, the applicant's amendments filed January 13, 2003 has not been entered and thus the rejections of claims 3, 4 and 9-13 are herein maintained.

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In view of the amendment dated February 5, 2003, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

- a) Claim 9 is vague and indefinite in that it is not known what is meant by “gastroenterpancreatic tumors”. It is believed the applicant’s intended gastroenteropancreatic tumors.

***Miscellaneous***

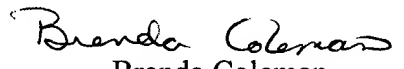
7. Applicant’s attention is drawn to claim 9 which is a composition claim, dependent on method claim 10 not on compound claim 11. Appropriate correction is requested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

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The fax phone number for this Group is (703) 308-4734 for “unofficial” purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Brenda Coleman  
Primary Examiner AU 1624  
February 13, 2003